



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Examining Operations

Applicant(s): McIntosh et al

Serial No: 10/067,121

Art Unit: 1644

Filed: 13 November 2001

Examiner: Belyavskyi, M. A.

TITLE: MESENCHYMAL STEM CELLS FOR PREVENTION AND TREATMENT
OF IMMUNE RESPONSES IN TRANSPLANTATION

Docket No.: 640100-441

17 July 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION OF INVENTION

Sir:

In response to the Notice of Restriction, dated 25 February 2003, Applicants respond by electing the invention of Group VII (claim 71) with traverse.

Applicants contend that the Restriction, as presently stated, does not allow for the full breadth of the claimed invention and needlessly limits the claims to a number of what Applicants believe to be mere species of the claimed invention. In addition, many of the suggested Groups of claims recite limitations, such as xenogeneic MSCs, that are not recited in the generic claims of the Group (see, for example, Groups I to III).

Applicants direct the Examiner's attention to the fact that the present application is a divisional of U.S. Serial No. 09/427,333, filed 26 October 1999 (now U.S. Patent 6,368,636), which was a continuation-in-part of U.S. Serial No. 09/267,536, filed 12 March 1999 (now U.S. Patent 6,328,960) (see Amendment filed with the present application).

In an attempt to resolve issues relating to the restriction, Applicants have filed herewith a Preliminary Amendment canceling most pending claims and leaving claims 71 and claim 72. In addition, Applicants have amended claim 71 to recite all of the limitations of claim 1 of the '960 patent and have added new claims 96-117, which track the other claims of the '960 patent.

Applicants believe that this adequately responds to the Restriction while also adequately encompassing the breadth of the invention and meeting the requirements of Group VII of the Restriction.

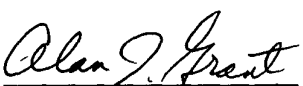
Claim 71, prior to amendment, was drawn to a process for treating a transplant recipient for graft-versus-host disease (GVHD) using mesenchymal stem cells (MSCs). However, GVHD results from an immune response of effector cells against an alloantigen and the claim employs MSCs to reduce this reaction.

Amended claim 71 is directed to "reducing an immune response of effector cells against a xenoantigen" which encompasses GVHD. In addition, where the graft is from an animal of a different species (a xenograft) the result is again an immune response of effector cells against the xenoantigen. In addition, claim 71, prior to amendment, is not limited to any particular kind of antigen (i.e., it does not recite an alloantigen) and a xenoantigen is one type of antigen. Thus, amended claim 71 now serves to limit the type of immune reaction to that against a xenoantigen (support for which is recited in the accompanying amendment).

Serial No. 10/067,121
Filed: 13 November 2001

In sum, original claim 71 was drawn to preventing GVHD (an immune response of effector cells produced by alloantigens or xenoantigens) by administering MSCs. As amended, claim 71 now recites preventing an immune response of effector cells against a xenoantigen by administering MSCs. Thus, amended claim 1 (and the other added claims) now clarify the claimed invention while at the same time falling within the ambit of original claim 71 (Group VII of the Restriction). Applicants believe that this amendment satisfies the technology encompassed by Group VII of the Restriction and that the claims are now in condition for examination.

Applicants have enclosed herewith a request for a 4 month extension of time (see accompanying Request under 37 C.F.R. 1.136(a)) and a check to cover the fee for a small entity. Applicants request that the Commissioner charge any additional fee set in 37 CFR 1.17 for this extension of time, or credit any overpayment, to Deposit Acct. No. 03-0678.

FIRST CLASS CERTIFICATE	
I hereby certify that this correspondence is being deposited today with the U.S. Postal Service as First Class Mail in an envelope addressed to:	
Commissioner for Patents P. O. Box 1450 Alexandria, VA 22313-1450	
 Alan J. Grant, Esq.	<u>7/17/03</u> Date

Respectfully submitted,



Alan J. Grant, Esq.
Reg. No. 33,389

CARELLA, BYRNE BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN
Six Becker Farm Road
Roseland, NJ 07068
Phone: 973-994-1700
Fax: 973-994-1744

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Examining Operations

Applicant(s): McIntosh et al

Serial No: 10/067,121

Art Unit: 1644

Filed: 13 November 2001

Examiner: Belyavskiy, M. A.

TITLE: MESENCHYMAL STEM CELLS FOR PREVENTION AND TREATMENT
OF IMMUNE RESPONSES IN TRANSPLANTATION

Docket No.: 640100-441

17 July 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT

Sir:

Prior to examination on the merits, Applicant requests that the application be amended as follows: